

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application of:	Weiner <i>et al.</i>	Confirmation No.:	8108
Patent No.	7,601,740	Issued:	October 13, 2009
Serial No.:	10/759,561	Art Unit:	1617
Filed:	January 15, 2004	Examiner:	Jennifer M. Kim
For:	SELECTIVE SEROTONIN 2A/2C RECEPTOR INVERSE AGONISTS AS THERAPEUTICS FOR NEURODEGENERATIVE DISEASES	Attorney Docket No:	12560-016-999
		CAM:	598154-999016

**RENEWED REQUEST FOR RECONSIDERATION OF  
PATENT TERM ADJUSTMENT**

**Mail Stop Petition**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Renewed Request for Reconsideration of Patent Term Adjustment is in response to the Decision on Request for Recalculation of Patent Term Adjustment in View of Wyeth mailed April 21, 2010 ("the April 21 Decision," a copy of which is attached as Exhibit A), and the Decision on Request for Reconsideration of Patent Term Adjustment mailed March 29, 2010 ("the March 29 Decision," attached as Exhibit B) in connection with the above-captioned patent.

The patent term adjustment under 35 U.S.C. § 154(b) indicated on the April 21 Decision is 1,663 days. The patent term adjustment under 35 U.S.C. § 154(b) indicated on the March 29 Decision is 1,259 days. As set forth below, it is believed that the correct patent term adjustment is 1,249 days.

The March 29 Decision states that Patentees are given one month or thirty days, whichever is longer, from the mail date of the decision to respond. Therefore, this Renewed Request for Reconsideration of Patent Term Adjustment is being timely filed on April 29, 2010.

**A. Statement of Facts Under 37 C.F.R. § 1.705(b)(2)**

Pursuant to 37 C.F.R. § 1.702, Applicants submit the following statement of facts in support of this Application for Patent Term Adjustment.

The patent term adjustment due to PTO delays is the sum of PTO delays under 35 U.S.C. § 154(b)(1)(A) and 35 U.S.C. § 154(b)(1)(B), minus Applicants' delay under 37 C.F.R. § 1.704. The details of this calculation are provided below.

**1. Patent Office Delays Under 35 U.S.C. §154(b)(1)(A)**

The number of days of Office delay under 35 U.S.C. § 154(b)(1)(A) is 904 days. The filing date of the instant patent is January 15, 2004. A first action was due March 15, 2005, *i.e.*, fourteen months after the date of filing. *See* 37 C.F.R. § 1.703(a)(1) (patent term adjustment is equal to the number of days "in the period beginning on the day after the date that is fourteen months after the date on which the application was filed...and ending on the date of mailing of...an action under 35 U.S.C. § 132...."); 35 U.S.C. § 154(b)(1)(A)(i). A Restriction Requirement was mailed July 5, 2007. Thus, Applicants submit that the period of Office delay for failure to issue an action within 14 months is 842 days.

A Response after non-final Office Action was filed January 10, 2008. Thus, an Office Action under 35 U.S.C. § 132, or a Notice of Allowance under 35 U.S.C. § 151, was due May 10, 2008. *See* 37 C.F.R. § 1.703(a)(2) (patent term adjustment is equal to the number of days "in the period beginning on the day after the date that is four months after the date on which a reply under 37 C.F.R. 1.111 was filed and ending on the date of mailing of...an action under 35 U.S.C. 132...."); 35 U.S.C. § 154(b)(1)(A)(ii). A final Office Action was mailed July 11, 2008. Thus, Applicants submit that the period of Office delay for failure to issue an Office Action within four months is 62 days.

Applicants submit that the total PTO delay under 35 U.S.C. § 154(b)(1)(A) is 842 days + 62 days = 904 days.

**2. Patent Office Delays Under 35 U.S.C. §154(b)(1)(B)**

"[I]f the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application...not including (i) any time consumed by continued examination of the application requested by the application under section 132(b)...the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued." 35 U.S.C. § 154(b)(1)(B). The instant application was filed on January 15, 2004. Thus, the

three-year anniversary of the filing date is January 15, 2007. Applicants filed a Request for Continued Examination on October 14, 2008, 637 days after the three-year anniversary. Because the period between October 14, 2008 and the issuance of a patent is excluded from patent term adjustment calculations, Applicants submit that the period of PTO delay under 35 U.S.C. § 154(b)(1)(B) is 637 days.

3. Total Patent Office Delays

The patent term adjustment due to PTO delays is the sum of Office delays under 35 U.S.C. § 154(b)(1)(A) and 35 U.S.C. § 154(b)(1)(B). To the extent that the period of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed. *See Wyeth v. Kappos*, 93 USPQ2d 1257, 1260 (Fed. Cir. 2010) (“If an A delay occurs on one day and a B delay occurs on a different day, those two days do not “overlap” under section 154(b)(2)”).

As discussed above, the PTO delay under 35 U.S.C. § 154(b)(1)(A) occurred from March 15, 2005 to July 5, 2007, and from May 10, 2008 to July 11, 2008. The period of Office delay under 35 U.S.C. § 154(b)(1)(B) was between January 15, 2007 and October 14, 2008. In these periods, a total of 233 calendar days overlap: 171 days between January 15, 2007 and July 5, 2007, and 62 days between May 10, 2008 and July 11, 2008. Accordingly, Applicants submit that the total patent term adjustment due to PTO delay is  $904 + 637 - 233 = 1,308$  days.

4. Applicants’ Delay under 37 C.F.R. § 1.704

Applicants submit that the number of days of Applicants’ delay is 59 days. An Information Disclosure Statement was filed on August 8, 2007, two days after the filing of a response to Restriction Requirement. Thus, Applicants’ delay was 2 days for the filing of a supplemental reply. *See* 37 C.F.R. § 1.704(c)(8).

A Request for Continued Examination was filed on October 14, 2008 in reply to a final Office Action mailed July 11, 2008. Thus, Applicants’ delay was 3 days for the filing of a reply after three months from the mailing date of an Office Action. *See* 37 C.F.R. § 1.704(b).

A Request to Correct Inventorship Under 37 C.F.R. 1.48(b) was filed on July 10, 2009, after the mailing of a Notice of Allowance. The PTO responded to the Request to

Correct Inventorship on September 1, 2009. Thus, Applicants' delay was 54 days for the filing of a paper after a Notice of Allowance. *See* 37 C.F.R. § 1.704(c)(10).

Accordingly, Applicants submit that the adjustment due to Applicants' delay is  $2 + 3 + 54 = 59$  days.

5. Total Patent Term Adjustment

In view of the above, Applicants submit that the total patent term adjustment is the difference between total Office delays under 35 U.S.C. § 154(b)(1)(A) and (B), and total Applicant delays, *i.e.*  $1,308 - 59 = 1,249$  days.

**B. Statement of Terminal Disclaimers Under 37 C.F.R. § 1.705(b)(2)(iii)**

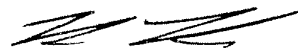
Pursuant to 37 C.F.R. § 1.702(b)(2)(iii), a request for reconsideration of patent term adjustment must be accompanied by a statement disclosing whether the application is subject a terminal disclaimer, and if so, the expiration date specified in the terminal disclaimer. No terminal disclaimers were filed in the above-captioned application. Therefore, Applicants submit that the correct patent term adjustment is 1,249 days.

**C. Conclusion**

The fee of \$200.00, which is believed due for the submission of this paper under 37 C.F.R. §1.18(e), will be paid via EFS Web. If any additional fees are due, the Commissioner is authorized to charge them to Deposit Account No. 50-3013 (referencing 598154-999016).

Respectfully submitted,

Date: April 29, 2010



Mark D. Kafka

Reg. No. 59,569

for: Anthony M. Insogna

Reg. No. 35,203

**JONES DAY**

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## EXHIBIT A



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

ACADIA PHARMACEUTICALS INC.  
3911 Sorrento Valley Blvd.  
San Diego, CA 92121

Mail Date: 04/21/2010

Applicant	: David M. Weiner	: DECISION ON REQUEST FOR
Patent Number	: 7601740	: RECALCULATION of PATENT
Issue Date	: 10/13/2009	: TERM ADJUSTMENT IN VIEW
Application No	: 10/759,561	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 01/15/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1663** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

## EXHIBIT B



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

MAILED

MAR 29 2010

JONES DAY  
222 EAST 41ST ST  
NEW YORK NY 10017

OFFICE OF PETITIONS

In re Patent No. 7,601,740 : DECISION ON REQUEST  
Weiner, et al. : FOR  
Issue Date: October 13, 2009 : RECONSIDERATION OF  
Application No. 10/759,561 : PATENT TERM ADJUSTMENT  
Filed: January 15, 2004 : and  
Atty Docket No.12560-016-999 : NOTICE OF INTENT TO ISSUE  
: CERTIFICATE OF CORRECTION

This is a decision on the petition filed on October 14, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand, three hundred and four (1,304) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand, two hundred and fifty-nine (1,259) days is **GRANTED to the extent indicated herein.**

As the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the "B" delay period, the over three year period begins on January 16, 2007, and ends on October 13, 2009, the day before the RCE was filed, and is 637 (not 638) days. See 35 U.S.C. 154(b)(1)(B)(i).

A review of the application file history reveals that on July 10, 2009, patentees submitted a "Request to Correct Inventorship Under 37 CFR § 1.48(b)", after the mailing of the notice of allowance, which under the circumstances of this application, is a ground for reduction of patent term adjustment under 37 CFR 1.704(c)(10).

37 CFR 1.704(c)(10) provides:



Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

or

(ii) Four months;

In this instance, it is undisputed that patentees filed the "Request to Correct Inventorship Under 37 CFR § 1.48(b)" after the mailing of the notice of allowance. It is noted that the period of reduction to the patent term adjustment is 44 days, beginning on the date the "Request to Correct Inventorship Under 37 CFR § 1.48(b)" was filed, July 10, 2009, ending on the date the response to the petition was mailed, September 1, 2009. Accordingly, a period of reduction of 44 days, will be entered.

In view thereof, the patent should have issued with a revised Patent Term Adjustment of one thousand, two hundred and fifty-nine (1,259) days, (1,541 days of Office delay - 49 (5 + 44) days of applicant delay - 233 of overlap).

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

The Office acknowledges receipt of \$200.00 for the fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Certificates of Corrections Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or

In re Patent No. 7,601,740

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adjusted by **one thousand two hundred and fifty-nine (1,259)** days.

Telephone inquiries specific to this matter should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.

A handwritten signature in cursive script, appearing to read "Christina Tartera Donnell for".

Christina Tartera Donnell  
Senior Petitions Attorney  
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

*In re Patent No. 7,601,740*

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**DRAFT COPY**

UNITED STATES PATENT AND TRADEMARK OFFICE  
**CERTIFICATE OF CORRECTION**

PATENT : 7,601,740 B2

DATED : Oct. 13, 2009

INVENTOR(S) : Weiner et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[\*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (899) days

Delete the phrase "by 899 days" and insert – by 1,259 days--